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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/700,929
	Filing Date	November 4, 2003
	First Named Inventor	Hoppe
	Art Unit	2878
	Examiner Name	Pyo, Kevin K.
	Attorney Docket Number	21295.70
Total Number of Pages in This Submission	4	

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <i>to restriction</i> <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to a Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks One month extension of time is requested. Authorization is given to charge the one-month extension fee to Deposit Account 502233.		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual	Maria M. Eliseeva, Reg. No. 43,328	
Signature	<i>Maria Eliseeva</i>	
Date	July 5, 2005	

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: <u>July 5, 2005</u>		
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Signature	<i>Maria Eliseeva</i>	Date July 5, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

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Application No. 10/700,929
Reply to Office Action dated May 4, 2005
Docket: 21295.70(H5704US)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re:	Martin Hoppe et al.	Patent Application
Serial No:	10/700,929	Confirmation No: 5952
Filed:	November 4, 2003	Group: 2878
For:	Method and Apparatus for Investigating Layers of Tissues in Living Animals Using a Microscope	Examiner: Pyo, Kevin K.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being faxed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 at 703-872-9306:

By: Maria Eliseeva Date: July 5, 2005

RESPONSE TO RESTRICTION REQUIREMENT

VIA FACSIMILE 703-872-9306
Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction requirement mailed on May 4, 2005, Applicant elects Claims 1-8 and 14-16. Applicant respectfully traverses on several grounds, including the one that no new search will be required for searching all groups of claims and that no undue burden will be imposed on the Patent Office.

Applicant also respectfully traverses the grounds of the present restriction requirement and wishes to place the application in better condition to appeal the restriction requirement.

The Examiner has stated:

"The inventions are distinct, each from the other because of the following reasons: [...]"

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper."

What 35 U.S.C. 121, the law, states in relevant part is: "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." Note that 37 C.F.R. §§ 1.141 and 1.142 also speak of "independent and distinct" inventions. The Patent Office has only argued that the inventions are distinct. The Patent Office has not

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also argued, as required by 35 U.S.C. 121, that the inventions are also independent. Therefore, the restriction requirement is improper and Applicant requests that it be withdrawn.

Note that Applicant does not consider the explanation of the meaning of "independent" and "distinct" in MPEP § 802.01 persuasive.

The MPEP §802.01 Meaning of "Independent" and "Distinct":

"35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This, in turn, depends on the construction of the expression "independent and distinct" inventions.

"Independent", of course, means not dependent. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that 35 U.S.C. 121: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term "independent" as already pointed out, means not dependent. A large number of subjects between which, prior to the 1952 Act, division had been proper, are dependent subjects, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the Commissioner never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, "distinct" inventions, even though dependent.

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and

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unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended."

The arguments presented in the MPEP seem to rest on two pillars:

- 1) Apparently, the novel statutory construction theory being put forward is that in the absence of legislative history on a given point, the law doesn't mean what the law says. Applicant submits that the statutory construction as described by the Supreme Court should be given deference: "[I]n interpreting a statute a court should always turn to one cardinal canon before all others. . . . [C]ourts must presume that a legislature says in a statute what it means and means in a statute what it says there." ¹ Certainly, "[w]hen the words of a statute are unambiguous, then, this first canon is also the last: 'judicial inquiry is complete.'" Id.
- 2) "Independent and distinct" has the same meaning as "distinct." This is a logical impossibility if "independent" and "distinct" have different definitions, yet MPEP § 802.01 concedes that that they do have different definitions and helpfully provides them.

Therefore, the applicants suggest that the Patent Officer has not satisfied the burden required under 35 U.S.C 121 in the restriction requirement. If the Patent Office wishes to maintain the restriction requirement, the Applicant respectfully requests that the Patent Office also explain how the subject matter represents "independent" inventions, according to the definition of "independent" given in MPEP § 802.01.

Respectfully submitted,
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Dated: July 5, 2005

¹ Connecticut Nat'l Bank v. Germain, 112 S. Ct. 1146, 1149 (1992).